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Paper No. 14
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MicroStrategy Incorporated

Serial No. 75/566,128

Michael J. Bevilacqua and Barbara A. Barakat of Hale and Dorr LLP for MicroStrategy Incorporated.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Chapman, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

MicroStrategy Incorporated has filed an application to register on the Principal Register the mark DSS SUBSCRIBER for goods identified, as amended, as "computer programs for use in publishing and creating customized forms in a wide variety of fields" in International Class 9.¹

Registration has been refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of

¹ Application Serial No. 75/566,128, filed October 6, 1998, based on applicant's assertion of a bona fide intention to use the mark in commerce.

applicant's failure to comply with a requirement to disclaim "DSS." These letters, according to the Examining Attorney, are the acronym for "decision support system," and are merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed.

When the refusal to register was made final, applicant appealed to this Board.² Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

It is the Examining Attorney's position that "DSS" is the acronym for "decision support system," which "describes software which facilitates the organization of information into a format usable for decision making" (brief, p. 3); that the evidence shows applicant is a leading provider of "DSS" software, and "applicant uses its mark [sic-DSS]? on a variety of DSS computer software products" (brief, p. 4); that the record "establishes a connection between applicant and DSS software" (brief, p. 3); that in light of this information, "it is difficult to suppose that DSS

² In the first Office action, a different Examining Attorney refused registration of the entire mark as merely descriptive under Section 2(e)(1). However, in the second Office action, that Examining Attorney withdrew the refusal of the mark as a whole under Section 2(e)(1), but required a disclaimer of "DSS." Thus, the issue of the descriptiveness of the mark as a whole is not before the Board.

SUBSCRIBER [software] has absolutely no DSS applications or DSS-related functions" (brief, p. 4); and that other meanings of the acronym "DSS" are not relevant in relation to applicant's goods. The Examining Attorney further argues that "the customized forms generated by DSS SUBSCRIBER [software] may well serve as an integral part of applicant's DSS platform." (Brief, p. 6.) From this, the Examining Attorney concludes that "DSS" is merely descriptive of a significant attribute of the goods on which applicant intends to use this mark because (i) the goods "are used in connection with other DSS-related products," and/or (ii) this software which is for publishing and creating customized forms "would assist in organizing and presenting the data in a form usable for decision-making" (brief, p. 5).

The record includes the following evidence submitted in support of the Examining Attorney's requirement for a disclaimer of "DSS":

- (1) a one-page printout from applicant's website titled "MicroStrategy DSS Suite Overview" and listing seven programs, DSS Broadcaster, DSS Web, DSS Agent, DSS Executive, DSS Server, DSS Administrator, and DSS Objects;
- (2) one page from the Acronyms, Initialisms & Abbreviations Dictionary (22nd ed.) listing over

75 meanings for "DSS," one of which is "Decision Support System";

- (3) one page from the on-line "Acronym Finder" stating that the "search for dss returned 95 definitions," and listing several definitions, one of which is "Decision Support System"; and
- (4) several excerpted stories retrieved from the Nexis database to show that "applicant's goods feature decision support systems used to create documents" (Final Office action, p. 1)³.

Applicant acknowledges that it sells decision support software which may be used with decision support system products.⁴ However, applicant contends that the goods involved in this application ("computer programs for use in publishing and creating customized forms in a wide variety of fields") are not decision support systems and are not for decision making, but rather are computer software programs for publishing and creating customized forms; and that, therefore, "DSS" has no meaning in connection with applicant's involved goods. Applicant further contends

³ We note that the Examining Attorney's searches of the Nexis database system were structured to include both "DSS" and "MicroStrategy." Thus, the searches precluded locating any other uses of the term "DSS" in relation to the identified goods or in relation to computer programs generally.

⁴ The Board takes judicial notice of the following definition of "DSS" from Webster's New World Dictionary of Computer Terms (Seventh Edition 1999): "Decision support system. A program designed to help management analyze data to make decisions on semi-structured problems."

that given the many meanings of "DSS" in both the acronym dictionary and the on-line acronym finder submitted by the Examining Attorney, "DSS" would not describe to potential purchasers the function or characteristics of applicant's involved goods; and applicant notes that the page from its website does not include any reference to the program involved in this application.⁵

Because we are dealing in this case with the Examining Attorney's requirement for a disclaimer of three letters as an acronym, we start with the guidance of the predecessor of our primary reviewing Court from the case of *Modern Optics, Incorporated v. The Univis Lens Company*, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956):

While each case must be decided on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.

⁵ In its brief on appeal (p. 4), applicant, for the first time, referred to attached copies of numerous third-party registrations including "DSS" in the marks, of which only two include disclaimers of the letters "DSS." First, there were no attachments with applicant's brief. Second, even if the photocopies of third-party registrations had been attached to the brief, they would be untimely filed under Trademark Rule 2.142(d), and the Examining Attorney properly objected thereto (brief, p. 6). We have not considered applicant's unsupported argument regarding third-party registrations which applicant asserts do not include disclaimers of the letters "DSS."

See also, *Avtex Fibers Inc. v. Gentex Corporation*, 223 USPQ 625 (TTAB 1984), and cases cited therein.

In order to determine whether matter is merely descriptive, it is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In *re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). In addition, the determination of mere descriptiveness must, of course, be made not in the abstract, but in relation to the goods or services for which registration is sought, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Both acronym reference sources clearly list many different meanings of "DSS," including, "decision support structure," "decisions support solutions," "data systems services," "data server system," "deep space station," and "department of social services." However, the page from applicant's website, as well as the stories regarding applicant retrieved from the Nexis database, all clearly indicate that these initials in relationship to *applicant*, *MicroStrategy Incorporated*, are intended to refer to "decision support system." The record is clear that

applicant uses the letters "DSS" in combination with other words for several different computer programs, a fact acknowledged by applicant.

The problem we have here is that we are otherwise left to speculation and conjecture because there is no evidence of record which establishes descriptive use of the acronym "DSS" in relationship to the specific *goods* which are the subject of this application; nor is there evidence which establishes that "DSS" is an abbreviation generally used and recognized by the consuming public when used for the identified goods. See *In re American Standard Inc.*, 223 USPQ 353 (TTAB 1984); and *In re Harco Corporation*, 220 USPQ 1075 (TTAB 1984). Cf. *In re The Yacht Exchange, Inc.*, 214 USPQ 406 (TTAB 1982).

Decision: The requirement under Section 6 for a disclaimer of the letters "DSS" is reversed.

Bucher, Administrative Trademark Judge, concurring:

The mark applicant has selected is DSS SUBSCRIBER. The goods on which it is to be applied are "computer programs for use in publishing and creating customized

forms in a wide variety of fields." The Trademark Examining Attorney postulated that the goods identified in this Intent-to-Use application might well be connected in some way to applicant's database management software. Evidently, the Trademark Examining Attorney was unable to prove the same in this record, and did not take advantage of her prerogative under Trademark Rule 2.61(b) to request additional information from applicant.

The Trademark Examining Attorney initially assigned to this application struggled to prove that the entire mark was merely descriptive of these goods. Then the current Trademark Examining Attorney went final when applicant refused to comply with her requirement that applicant simply disclaim the term "DSS" apart from the mark as shown. Instead, applicant argues that "... the term DSS has no meaning in connection with appellant's goods." (Applicant's appeal brief, p. 4).

From the contents of this file, we see the press reports that applicant is "... a leading worldwide provider of mission critical *decision support systems*."⁶ Like the Trademark Examining Attorney herein, I too was of the

⁶ And unlike my colleagues, I am quite comfortable once again in concluding that whenever this applicant uses the initialism "DSS," the relevant public understands it to be "substantially synonymous" with the highly descriptive term, "Decision Support System." See Modern Optics, Inc., *supra*.

impression that applicant is a vendor of information technologies, whose software permits its business customers to extract business intelligence, like water, from terabyte-sized swamps of undifferentiated data. As applicant's software has matured over the years (e.g., DSS Agent, DSS Executive, DSS Broadcaster, or MicroStrategy 7 Business Intelligence Platform), the on-going focus for Michael J. Saylor and company has been making it possible for thousands of users in hundreds of enterprises more easily and quickly to access/query large volumes of data. Presumably, individuals having a good DSS engine equipped with unlimited DSS customization capabilities can be most proactive in finding and integrating key business information.

Of course, this panel earlier decided the case of the descriptiveness of the alleged mark, DSS BROADCASTER. In the face of a thin record offering inadequate proof of descriptiveness in that case, the majority bent under the weight of applicant's equally adamant arguments therein that the involved goods did *not* amount to a "Decision Support System." Yet in that case, the identification of goods were more clearly a DSS -- computer software for *on-line analytical processing* [OLAP] and data analysis, namely, processing and analyzing data for the purpose of

delivering customized and personalized information to targeted recipients."

It is true, of course, that in the instant application, we have no OLAP or other direct reference to a decision support system. Following the introductory wording about "computer programs" comes a cryptic reference to "publishing and creating customized forms."

Precisely, what are these goods in International Class 9, or what is their objective? The underlying goods are computer programs, or software. Applicant's software will be used to create "forms." In this context (i.e., when dealing with data bases), the word forms is a term of art. This is clearly not a reference to printed forms, but rather suggests a predefined grouping of functions, called from a menu and displayed, if necessary, on several windows. Forms have blocks, regions and fields as their components.

Customizable forms are generally forms that the vendor, one's system administrator, or even the non-technical user, can modify for ease of use. In such a software module, the form-customization window lists available forms and their methods of customization. In addition to customizing database forms, such a module may

even allow DSS users to customize reports and inquiries for almost any business application.⁷

Furthermore, consistent with this interpretation, looking back to the identification of goods in the DSS BROADCASTER application, we see language of "...delivering customized and personalized information to targeted recipients." Hence, I admit that I share the suspicions of the Trademark Examining Attorney that the goods herein would consist of a software module permitting the content of forms, if not reports and other queries, to be personalized to the needs of applicant's customers' individual subscribers.

In fact, from applicant's own Web page, under a tab for MicroStrategy 7 Business Intelligence Platform, under "query and reporting," we learn that "users can *subscribe* to frequently used reports," and from "Web-based reporting," that "navigation bars quickly allow prompting, *subscription* and drill capabilities ..."

⁷ In addition to the identifications of goods contained in a listing of federal trademark registrations owned by Microsoft, Sybase, Lotus, Oracle, and others, note in particular the clearer identification of similar business intelligence software of Reg. No. 2,388,279 for the mark SQLBASE EXCHANGE (owned by Centura Software / Gupta Technologies): "computer software used for data storage and reporting, which allows users to customize database forms, reports and inquiries for any business application ..."

Nonetheless, because we are not permitted to engage in speculation beyond the four corners of the current record, I concur with the majority opinion that given applicant's adamant arguments to the contrary, we must reverse the Office's position herein. However, with a different record, we should have been able to affirm the Trademark Examining Attorney.